

## REMARKS

Claims 22-28 are pending in this application. Claims 22-28 were rejected under the doctrine of obviousness-type double patenting and under 35 U.S.C. §103(a). By virtue of this amendment, claims 25 and 28 have been amended and new claims 29 and 30 have been added.

### Double Patenting

Claims 22-28 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,639,657 issued to Baer et al. (hereinafter “the ‘657 Patent”). In particular, the Office states:

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims 1-8 of Patent No. 6,639,657 (‘657 hereinafter) indirectly disclose all the limitations of the claims 22, 26-28 in this application. Claims of ‘657 does not disclose the structure of the joystick as claimed in claims 23-25. However, the claimed joystick’s structure would have been an obvious modification.

Applicants believe that the double-patenting rejection is improper and should be withdrawn. The present patent application is a divisional application of U.S. Patent Application Serial No. 09/121,677 which is now the ‘657 Patent. Also, the present patent application was filed before the issuance of the ‘657 Patent and therefore was co-pending with the ‘657 Patent. The claims of the present patent application were restricted from the ‘657 Patent. 35 U.S.C. 121 states:

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. *A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or*

**in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.** If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

35 U.S.C. 121 (emphasis added).

The third sentence of 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. MPEP §804.01. Because (1) claims 22-28 of the present invention were first presented on July 10, 2002 prior to the issuance of the ‘657 Patent and (2) subject to a restriction requirement in Paper No. 23 in the prosecution of the ‘657 Patent and (3) wherein claims 22-28 are the same claims that were restricted out of the ‘657 Patent and are now the subject matter of the present application and (4) wherein the same claims have been filed as a divisional of the ‘657 Patent before the issuance of the ‘657 Patent; now therefore, the double-patenting rejection is improper.

Furthermore, claims 22-28 in the present application are apparatus claims and claims 1-8 of the ‘657 Patent are method claims. Therefore, the product claims 22-28 of the present invention are patentably distinct and distinguishable from the method claims 1-8 of the ‘657 Patent. The prohibition against holdings of double patenting applies to requirements for restriction between the related subjects namely between process and apparatus for its practice or between combination and subcombination. MPEP §804.01. In Paper No. 23 in the file history of the ‘657 Patent, the Office states in the Restriction Requirement that

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as combination and subcombination.

Paper No. 23, pg. 2. The claims of the present invention were restricted as Group II claims of the '657 Patent. For all of these reasons, the double patenting rejection is improper and should be withdrawn.

**Rejections under 35 U.S.C. §103(a)**

Claims 22-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,257,091 issued to Caicedo, Jr. et al. (hereinafter "Caicedo"). In particular, the Office states with respect to independent claim 22 and independent claim 28 that:

...Caicedo discloses a system. The system comprises: a microscope 19 (fig 1), a laser 17 (fig 2) connected to the microscope (column 3, lines 30-35), a translation stage (column 3, lines 30-35), a joystick connected to the translation stage 61, 63 (fig 3).

Caicedo does not disclose the joystick's configuration as claimed. However, it would have been obvious to modify Caicedo's joystick to perform the function as claimed for different testing purposes or different samples.

Caicedo does not explicitly disclose the claimed optical path and beam path. However, a microscope having an optical path and a laser having a beam path would have been obvious.

With respect to claims 23-24, Caicedo does not explicitly disclose the structure of the joystick as claimed. However, it would have been obvious to modify Caicedo's joystick with different structures for different uses.

With respect to claim 25, Caicedo discloses using a joystick to control the movement of the translation in X, Y axes (column 3, lines 30-35).

With respect to claims 26-27, it would have been obvious to modify Caicedo's joystick with different leverage ratio for handling different samples.

With respect to claim 28, refer to discussion in claim 22 above.

Applicants traverse this rejection. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art

to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. MPEP §2143.

### **Independent Claim 22**

With respect to independent claim 22, Caicedo does not disclose, teach or suggest the claim limitation of a joystick being configured to reduce a scalar movement defined by an operator. In order to establish a prima facie case of obviousness, the prior art reference must teach or suggest all the claim limitations. MPEP §2143. Caicedo only states that “[a]n XZ joystick 61 can be provided for fine control of the X and Z translation stages 11, 15, and a Y joystick 63 can be provided for fine control of the Y translation stage 13.” Caicedo, col. 4, lines 60-63. Caicedo does not provide one having ordinary skill in the art with motivation to modify Caicedo’s joystick such that it is configured to reduce the scalar movement defined by the operator as claimed. Nor is there any suggestion or motivation in the knowledge generally available to one skilled in the art to modify Caicedo. Caicedo’s joystick satisfies the purpose of the invention in Caicedo and there is no suggestion or motivation in Caicedo or in the knowledge generally available to one skilled in the art to change Caicedo. For these reasons and because Caicedo does not teach or suggest all of the claim limitations, namely, a joystick being configured to reduce a scalar movement defined by an operator, a prima facie case of obviousness is not established.

Furthermore, Caicedo does not disclose, teach or suggest the claim limitation of the joystick having a leverage ratio as a function of operator hand movement to control sample movement. In order to establish a prima facie case of obviousness, Caicedo has to teach or suggest all of the claim limitations and it does not teach or suggest the claim limitation of a joystick having a leverage ratio to control sample movement as a function of operator hand movement. The specification of the present invention in paragraph [0047] states that:

Mechanical leverage is provided by the fact that the length between the spherical mounting 152 and the second spherical mounting 156 is less than the length between the second spherical mounting 156 and the bottom end of the joystick 150. This leverage ratio is not needed for multiplication of force, but for the reduction in scalar movement. This ratio should be less than 1/5, preferably approximately 1/7. **This ratio can be adjusted to provide the optimal resolution needed in terms of sample movement as a function of operator hand movement.**

(emphasis added) Nothing in Caicedo discloses, teaches or suggests these limitations.

Therefore, independent claim 22 and its respective dependent claims are nonobvious and in a condition for allowance.

Also with respect to claim 22, Caicedo does not disclose, teach or suggest a laser capture microdissection instrument as recited in the preamble. Because Caicedo does not disclose, teach or suggest a microdissection instrument, Caicedo fails to meet the third criterion listed above for establishing a prima facie case of obviousness. Furthermore, there would be no reasonable expectation of success to modify Caicedo and turn it into a microdissection instrument. Caicedo discloses an optical alignment system for optically aligning the tape head assembly of a computer tape cartridge drive by non-contactive optical gauging. In Caicedo, a laser interferometer 17 is used to measure a small distance. Furthermore, in Caicedo, “the translation stage is fixedly secured to a stable base 23 comprising for example a granite block.” Caicedo, col. 3, lines 41-42. The translation stage is fixed and the “interferometer 17 and the microscope 19 are fixedly secured to the support structure 25 such that the interferometer/microscope assembly 20 moves as one unit.” Caicedo, col. 3, lines 48-51. Given these significant differences, there is no reasonable expectation of success to modify Caicedo into a laser microdissection instrument and to further modify the joystick in at least two ways mentioned above, without rendering Caicedo useless for its intended purpose for measuring and aligning the tape head assembly of a computer tape cartridge. For all of these reasons, independent claim 22 is non-obvious and in a condition for allowance. For at least the same reasons, claims dependent on independent claim 22 are also non-obvious and in a condition for allowance.

With respect to the dependent claims 23-28, these claims further include limitations that are not disclosed, taught or suggested in Caicedo. In order to establish a prima facie case of obviousness, the prior art reference must teach or suggest all the claim limitations. MPEP §2143. The additional claim limitations appearing in dependent claims 23-28 include a handle, a first spherical mounting, a first bracket, a second spherical mounting, and a second bracket; the translation stage is connected to the first spherical mounting via the first bracket; the first spherical mounting is connected to the handle via the second spherical mounting in the second static bracket; and the handle includes a bottom end as recited in claim 23. As recited in claim 24, the limitation of the distance between the first spherical mounting and the second spherical mounting is less than the distance between the second spherical mounting and the bottom end of the handle and various leverage ratio is not taught or suggested in Caicedo. Because these limitations are not taught or suggested in Caicedo they are not obvious and also in a condition for allowance.

Dependent claim 25 is currently amended to delete the word “manual” in order to make the claim consistent with the independent claim 22 from which claim 24 depends. A new dependent claim 30 is added to re-capture this claim limitation of a manual joystick. Similar amendments are made to claims 28 and a new claim 29 is added to include the limitation of a manual joystick.

### **Independent Claim 28**

Independent claims 28 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Caicedo for the same reasons as independent claim 22. With respect to independent claim 28, applicants have amended this claim to clarify the invention. In particular, claim 28 was amended to include the limitation of a laser microdissection instrument. This limitation was included from the preamble. Applicants believe that the prior art does not disclose, teach or suggest the claim as amended. Furthermore, modifying Caicedo into a laser microdissection instrument would render it useless for its intended purpose as an optical alignment system. For

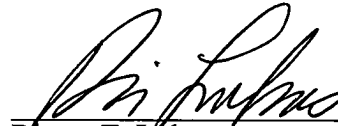
these reasons, independent claim 28 and its respective dependent claim are in a condition for allowance.

If it is determined that a telephone conversation will expedite prosecution of this application, the Examiner is requested to telephone the undersigned attorney at the number given below. In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time.

Respectfully submitted,

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